

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VAN L. PHILLIPS

Appeal No. 1999-0242
Application 08/643,829

HEARD: May 17, 2000

Before ABRAMS, MCQUADE, and BAHR, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Van L. Phillips originally took this appeal from the final rejection of claims 17 through 32. Inasmuch as the appellant has since canceled claims 17 through 27, the appeal now involves claims 28 through 32, the only claims presently pending in the application.

The invention relates to "a construction which permits the attachment of a prosthetic device having a relatively flat

surface to the exterior of a prosthetic pylon which has a generally curvilinear exterior" (specification, page 1).

Claim 28 is representative and reads as follows:

28. A prosthesis for attachment to the lower end of a round pylon, said prosthesis comprising:
a coupling member having on one side a curved concave mating surface conforming substantially to a curved convex outer mating surface of said pylon and on an opposite side a substantially flat mating surface;
a foot member having an upper attachment section having on one side a substantially flat mating surface substantially conforming to said flat mating surface of said coupling member; and
said mating surfaces being oriented substantially parallel to the longitudinal axis of said pylon when said corresponding conforming mating surfaces are mated together such that an axial load placed on said pylon produces a corresponding shear force on said mating surfaces in a direction substantially parallel to the longitudinal axis of said pylon.

Claims 28 and 30 through 32 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 2,897,512 to Sackett, and claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sackett.

Reference is made to the appellant's main and reply briefs (Paper Nos. 22 and 28) and to the examiner's final rejection and answer (Paper Nos. 7 and 24) for the respective positions of the

appellant and the examiner regarding the merits of these rejections.¹

Sackett discloses an artificial leg having an ankle/foot portion 43, a shin portion 42, a knee portion 41 and an upper bucket portion 40 housing a cast fitting 44 for receiving the stump of an amputee. Of particular interest is the knee portion which includes a circular socket 50 and an alignment table 51 having a semi-circular apertured extension 54 (see Figures 4 and 5). The socket 50 and table 51 are connected together via intersecting slots 52, 52' and a bolt and nut assembly 53. The socket 50 is secured to the cast fitting 44 and the table extension 54 is secured by a cross bolt 54' to a semi-circular recess 56 in a knee joint component 55.

The 35 U.S.C. § 102(b) rejection of independent claim 28 rests on examiner's determination that Sackett "illustrates a coupling member (Figures 4 and 5) having a concave cylindrical

¹ In the final rejection, claims 28 through 32 also were rejected on the grounds of obviousness-type double patenting. Since this rejection was not restated in the answer, it is assumed to have been withdrawn (see Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957)) in light of the terminal disclaimer which is of record.

surface on the top side (defined by the socket member **50**) and a flat mating surface on the bottom side (formed on the extension **54**) and a foot member having a flat mating surface **56**" (final rejection, pages 3 and 4). The examiner also finds that

[s]hear forces produced by axial loads placed on the leg prosthesis of Sackett occur in at least two ways. Firstly, an axial load associated with the weight of the amputee generally imparts torque about the cross bolt **54**' such that torsion (and thus shear) exists on the mating flat surfaces of elements **54** and **55** in the Sackett device. Secondly, during the swing phase of a gait cycle, the weight of the foot member combined with the upward pull exerted on the cast fitting **44** effects longitudinally directed forces which, at the level of the flat mating surfaces, take on the form of shear stresses. . . . The curved mating surface within the socket member **50** of Sackett is clearly *capable* of mating with a complementary round pylon so as to achieve shear forces on the resultant coupled surfaces; this is accomplished, for example, by securing the two parts with laterally oriented bolts or by bonding the curved surfaces together with an adhesive. Thus the functional language set forth in Appellant's claim 28, lines 9-13, is plainly met by the structure of the Sackett components [answer, page 4].

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444,

221 USPQ 385, 388 (Fed. Cir. 1984). Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)(quoting Hansgirk v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

As indicated above, the examiner considers the opposing flat surfaces on Sackett's extension 54 and recess 56 to meet the limitations in claim 28 pertaining to the coupling member flat mating surface and the foot member flat mating surface, respectively. Sackett, however, is silent as to whether these

flat surfaces are subject to a shear force of the sort defined in claim 28. The examiner's conclusion that they are (presumably under principles of inherency) is necessarily predicated on a number of assumptions as to the structural relationships between Sackett's extension 54, recess 56, cross bolt 54' and cross bolt apertures. The problem here is that Sackett does not provide any meaningful disclosure which supports these assumptions. The relevant disclosure in the reference is ambiguous at best and merely holds out the possibility that the opposing flat surfaces on extension 54 and recess 56 are subject to a shear force as required in claim 28. This mere possibility is not sufficient to meet the claim limitations in question.

Thus, the examiner's determination that Sackett discloses each and every element of the invention set forth in claim 28 is unsound. Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claim 28, or of claims 30 through 32 which depend therefrom, as being anticipated by Sackett.

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In addition to not disclosing a prosthesis meeting the flat mating surface limitations in claim 28, Sackett would not have suggested same to one of ordinary skill in the art. Therefore, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of

claim 29, which depends from claim 28, as being unpatentable over Sackett.

The decision of the examiner is reversed.

REVERSED

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Administrative Patent Judge)	
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)	BOARD OF PATENT
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